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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,464	03/25/2004	Ryan Cunningham	U000-P04042US	9324

33356 7590 03/09/2007  
SoCAL IP LAW GROUP LLP  
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EXAMINER
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MANIWANG, JOSEPH R

ART UNIT	PAPER NUMBER
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2144

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/810,464

Applicant(s)

CUNNINGHAM ET AL.

Examiner

Joseph R. Maniwang

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 61-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/27/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

1. The present application is a continuation of U.S. Pat. App. No. 09/545,639, filed 04/07/00.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 67-69 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Regarding claims 67-69, "A program product for use in a computer system that executes program steps recorded in a computer-readable media...the program product comprising: a recordable media, and a program..." is non-statutory, as the various recited "media" and the "program product" can be interpreted as intangible subject matter based on the disclosure provided, and therefore not tangibly embodied in a manner so as to be executable. The Specification does not specifically define a "computer-readable media" or a "recordable media" and could thus be considered various intangible media such as transmission media (e.g., carrier waves, signals, etc.). Additionally, a "program product" is described in the Specification as containing program steps, i.e., software, per se, which is non-statutory subject matter (see Specification, p. 13, paragraph [0048]). Furthermore, the claims are directed to a program within a

media (whether tangible or intangible), which can be considered non-functional descriptive material and thus non-statutory for lacking functionality.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 61-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Radziewicz et al. (U.S. Pat. No. 5,854,897), hereinafter referred to as Radziewicz.

7. Regarding claims 61, 64, and 67, Radziewicz disclosed a method and system comprising a user computer requesting a first web page via a network connection (see column 11, lines 30-33); displaying the first web page in a browser window (see column 5, lines 22-27; Fig. 8A); detecting if the user computer is not actively sending and not actively receiving data via the network connection, and if so, commencing downloading at least one full-motion video file via the network connection to the user computer (see column 5, lines 43-47, 53-54; column 6, lines 13-32, 36-39); during downloading the at least one full-motion video file, detecting if the user computer is commencing downloading a second web page, and if so, waiting to continue downloading the at least one full-motion video file (see column 11, lines 41-44); after completing downloading the at least one full-motion video file, independent of the user computer receiving user input, preempting viewing of the first web page, preempting viewing of the second web

page, and automatically commencing displaying the at least one full-motion video file on the user computer without removing the displaying of the browser window (see column 5, line 51 through column 6, line 1; Fig. 8A); during displaying the at least one full-motion video file on the user computer, providing control of the browser window, providing selective displaying sizing no smaller than a predetermined minimum size, and providing displaying run time between 30 seconds and 2 ½ minutes (see column 5, line 64 through column 6, line 12; column 18, lines 54-58; Fig. 8A); providing a hyperlink for requesting a third web page (see column 12, lines 23-45; column 18, lines 58-63); determining that the at least one full-motion video file should not displaying after the at least one full motion-video file displayed a predetermined number of times per predetermined time period (see column 7, lines 18-54; column 9, lines 24-41).

8. Regarding claims 62, 65, and 68, Radziewicz disclosed the method and system further comprising sending a questionnaire to the user computer prior to commencing downloading the second web page (see column 8, lines 1-15; column 14, lines 1-19).

9. Regarding claims 63, 66, and 69, Radziewicz disclosed the method and system wherein displaying the at least one full-motion video file is via a window distinct from a window displaying the first web page (see column 13, lines 15-23; Fig. 8A).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Berstis et al. (U.S. Pat. No. 7,089,194)

Servan-Schreiber et al. (U.S. Pat. No. 6,892,354)

Krishan et al. (U.S. Pat. No. 6,442,529)

Martin et al. (U.S. Pat. No. 6,363,419)

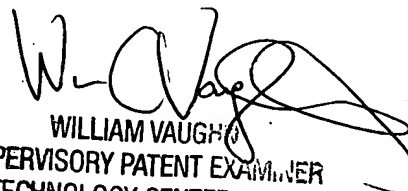
Landsman et al. (U.S. Pat. No. 6,317,761)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM

  
WILLIAM VAUGHN  
SUPERVISORY PATENT EXAMINER  
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